

**REMARKS**

In the Office Action, claims 1-13 were indicated as withdrawn from consideration and claims 14-37 were rejected. By the present Response, claims 1-13 are canceled without prejudice, and claim 14 is amended. Upon entry of the amendments, claims 14-37 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

**Confirmation of Election**

The Applicants, hereby, confirm the election without traverse to prosecute claims 14-37.

**Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 14-16 and 18-21 under 35 U.S.C. § 102 as being anticipated by Brandt et al., U.S. Patent No. 6,095,867 (hereinafter Brandt). Claim 14 is independent. Applicants respectfully traverse this rejection. A *prima facie* case of anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice, or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

**Independent Claim 14 and Claims Depending Therefrom**

With regard to independent claim 14, Brandt does not disclose at least that "each of the power and data conductors presents a respective elongate connection edge opposite the support edge, the connection edges being generally aligned in a plane for receiving respective connector elements" as recited by independent claim 14, as amended. The Brandt reference does not disclose elongate connection edges for each of power and data conductors. The power and data conductors in Brandt, cited to by the Examiner, only provide connections along their short sides or ends and not along their elongated edges. *See e.g.*, Brandt, Figures 9-11. The power and data conductors of the instant claims, however, have elongated connection edges that are opposite the support edges. *See, e.g.*, Figure 5.

The system proposed by Brandt is, in fact, a connector that takes data and power signals from a closed cable. The reference does not in any way set forth a rail system. While claim 14 has been amended to clarify the configuration of the rail system recited, Applicants point out that the internal features of the connector relied upon by the Examiner in no way constitute a similar rail system. Rather, as shown in Figure 11 of Brandt, the conductors internal to the connector present prongs that do not form rails at all. The amendments are intended to clarify that the rail system of claim 14 includes elongate conductors, both for power and data signals that present edges opposite their support edges that are aligned to receive respective connector elements. Any gratuitous similarity between the general wording of claim 14 and the internal prongs of Brandt is therefore avoided by the additional recitations added by the amendment.

Because the Brandt reference does not disclose the recited features of claim 14, as amended, the reference cannot anticipate claim 14. Accordingly, independent claim 14, and the claims that depend thereon, are believed allowable over the cited reference.

### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 17 and 22-37 under 35 U.S.C. § 103 as being unpatentable over Brandt. Claims 22 and 32 are independent. Applicants, as discussed further below, respectfully assert that the instant claims are not obvious in view of the cited reference.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the modification. See *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that a references can be modified does

not render the resultant modification obvious unless the prior art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the modified reference includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the reference. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to modify the cited reference. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002).

**Independent Claim 22 and Claims Depending Therefrom**

Independent claim 22 recites a rail system for transmitting power and data signals comprising, among other things, *a second set of power conductors* supported lengthwise on the support and configured to conduct electrical power. The Examiner acknowledged that Brandt “lacks a second set of power conductors.” Office Action, page 5. However, the Examiner asserted that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a second set of power conductors, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.” *Id.*, at 5-6 (note that the published case is not located at the cite provided by the Examiner). The Applicants respectfully traverse this assertion.

The issue in *St. Regis Paper* was whether a patent is valid if it combines old elements disclosed in the prior art with elements previously known in the industry to create a novel combination. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977). The Seventh Circuit ruled that inventions that “rearrange old elements in new combinations with each element performing the same function it performed in the prior art” can not easily satisfy the requirements of 35 U.S.C. § 103. *Id.* However, the court

held that such an invention could be patentable, if the combination is synergistic, meaning that the combination results in an effect greater than the sum of the old elements taken separately. *Id.* Applicants respectfully point out that the court in *St. Regis Paper* did not hold that “mere duplication of the essential working parts of a device involves only routine skill in the art”, as the Examiner suggested. The *St. Regis Paper* case involved combination of old elements disclosed in the prior art with elements previously known in the industry and not “mere duplication of essential working parts of a device.” *Id.*

Furthermore, Applicants point out that the Federal Circuit does not follow the “synergistic” test adopted in *St. Regis Paper*. In fact, the Federal Circuit believes it is “simplistically unrealistic” to use a separate test of patentability for combination of old elements, when the statute does not support applying different treatments to different “types” of patents. *Raytheon Co. v. Aeroquip Corp.*, 220 USPQ 592, 600 (Fed. Cir. 1983). The Federal Circuit stated in *Chore-Time Equip., Inc. v. Cumberland* that “a requirement that an invention reflect ‘synergism’ or achieve a ‘synergistic’ result, before it may be held patentable appears nowhere in the statute, 35 U.S.C. The test of obviousness under 35 U.S.C. § 103, as the statue makes plain, is whether the invention as a whole would have been obvious at the time it was made to one of ordinary skill in the art.” *Chore-Time Equip., Inc. v. Cumberland*, 218 USPQ 673, 677 (Fed. Cir. 1983). Moreover, the Federal Circuit has held that in “determining whether a new combination of known elements would have been obvious in terms of 35 U.S.C. 103, the analytic focus is in upon the state of knowledge at the time the invention was made. The Commissioner bears the burden of showing that such knowledge provided some teaching, suggestion, or motivation to make the particular combination that was made by the applicant.” *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993). Accordingly, to assert that a new combination of old elements is unpatentable under 35 U.S.C. § 103, the Examiner is required to show that the invention as a whole would have been obvious to one of ordinary skill in the art at the time it was made.

Additionally, even if a showing of a synergistic effect was to be required, Applicants respectfully assert that combining a second set of power conductors with a first set of power conductors, as recited in the claim, does create an effect greater than the sum of the old elements taken separately. The additional set of power conductors, recited in the claim, permits the supply of a different kind and level of power not available through the first set of power conductors. As illustrated in Figures 7a-7c, the second set of power conductors, recited in the instant claims, could conduct various kinds and levels of power. *See, e.g.*, Figures 7a-7c. For example, as shown in Figure 7a, the second set of power conductors could carry 120V ac power, while the first set carry 24V dc power. Accordingly, the combination of a second set of power conductors with a first set of power conductors, as recited in the instant claims, is synergistic.

In the system described by Brandt, quite the contrary, low voltage power required by the networked devices, as well as the data signals, are distributed via the four-conductor cable. The connectors taught by Brandt are then secured to the cable and provide only this low voltage power and data signals. The higher power levels needed for operation of certain devices in such networks, such as relays, motor controllers, across-the-line starters, and so forth, are generally provided in completely separate cables not mentioned or discussed by Brandt. Accordingly, the system of Brandt, in fact, teaches an entirely different construction, in which low-level power and data signals *alone* are provided through one system with any additional power types and levels being provided through a completely separate network of power distribution. Accordingly, Brandt does not suggest to one skilled in the art, nor would one skilled in the art glean from Brandt that a rail system could be used for distribution of two different power levels and data in a configuration such as that set forth in claim 22. In short, the addition of second power conductors and the arrangement of these power conductors with data and first power conductors in a rail system is not simply a replication or duplication of parts of Brandt, but it is a completely different system that operates in a completely different manner.

With the forgoing reasons in mind, and given the shortcomings of Brandt with regards to the recitations of claim 22, Applicants submit that a *prima facie* case of obviousness has not been made by the Examiner. Moreover, Applicants believe that all of the pending dependent claims are equally allowable both by virtue of their dependency from an allowable base claim, and for the subject matter they separately recite. Accordingly, Applicants respectfully request reconsideration and allowance of the instant claims.

**Independent Claim 32 and Claims Depending Therefrom**

Independent claim 32 recites an open rail system for transmitting power and data signals comprising, among other things, “*a second set* of power conductors supported lengthwise on the support at positions flanking respective power conductors of the first set and configured to conduct electrical power.” The Examiner acknowledged that Brandt “lacks a second set of power conductors.” Office Action, page 7. However, the Examiner asserted that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a second set of power conductors, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 3 USPQ 8.” *Id.*, at 7-8. The Applicants respectfully traverse this assertion.

With the forgoing reasons in regards to claim 22 and given the shortcomings of Brandt with regards to the recitations of claim 32, Applicants submit that, here again, a *prima facie* case of obviousness has not been made by the Examiner. Moreover, Applicants believe that all of the pending dependent claims are equally allowable both by virtue of their dependency from an allowable base claim, and for the subject matter they separately recite. Accordingly, Applicants respectfully request reconsideration and allowance of the instant claims.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: August 6, 2004

Pg  
Patrick S. Yoder  
Reg. No. 37,479  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545

**CORRESPONDENCE ADDRESS**

ALLEN-BRADLEY COMPANY, LLC  
Patent Department/704P Floor 8 T-29  
1201 South Second Street  
Milwaukee, Wisconsin 53204  
Attention: Mr. Alexander Gerasimow  
Phone: (414) 382-2000